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— REMARKS —

The present amendment replies to a Non-Final Office Action dated January 20, 2006. Claims 1-22 are pending in the present application. In the Non-Final Office Action, the Examiner rejected pending claims 1-5, 9-15, and 19-22 on various grounds. The Examiner objected to claims 6-8 and 16-18 as depending on rejected claims, but found them allowable if rewritten in independent form. The Applicants respond to each ground of rejection as subsequently recited herein and respectfully requests reconsideration of the present application.

A. Claims 1, 10, 11, and 19-22 were rejected under 35 U.S.C. §102(e) as being anticipated by Chua, *et al.* (US 2004/0121783).

The §102(e) rejections of claims 1, 10, 11, and 19-22 is traversed. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the . . . claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Thus, to warrant the §102(e) rejection of claims 1, 11, and 19, U.S. Patent Application No. 2004/0121783 to Chua, *et al.* (the *Chua* application), must show each and every limitation of independent claims 1, 11, and 19 in as complete detail as contained in the independent claims.

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The *Chua* application fails to disclose, teach, or suggest:

a method for operating a telematics unit within a mobile vehicle communication system including assigning a primary telematics unit identifier to a user account and assigning the primary telematics unit identifier to a mobile handset, as recited in independent claim 1;

a computer readable medium for operating a telematics unit within a mobile vehicle including computer readable code for assigning a primary telematics unit identifier to a user account and computer readable code for assigning the primary telematics unit identifier to a mobile handset, as recited in independent claim 11; or

a system for operating a telematics unit within a mobile vehicle including means for assigning a primary telematics unit identifier to a user account and means for assigning the primary telematics unit identifier to a mobile handset, as recited in independent claim 19.

The *Chua* application fails to disclose a primary telematics unit identifier, i.e., an identifier associated with a telematics unit in a primary vehicle. The *Chua* application discloses a microprocessor 136 can receive identity information of wireless telephone 110 and vehicle 120. The identity information may comprise, for example, serial numbers of wireless telephone 110 and vehicle 120. For wireless telephone 110, the identity information may be one or more of the electronic serial number (ESN) and the mobile identification number (MIN) of wireless telephone 110. For vehicle 120, other identification methods may be used. For example, location system 124 may be assigned a unique number, such as vehicle identification number (VIN). The unique number

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serves as the identity information of vehicle 120. *See* paragraph [0031]. The *Chua* application fails to disclose that any telematics unit is a primary telematics unit, i.e., the telematics unit within the primary vehicle as defined in paragraph [0049] of the present application. Therefore, the *Chua* application cannot disclose a primary telematics unit identifier as recited in independent claims 1, 11, and 19.

The *Chua* application also fails to disclose assigning the primary telematics unit identifier to a subscriber account. The *Chua* application discloses service features subscribed to by the user of wireless telephone 110, but fails to disclose assigning a primary telematics unit identifier to a subscriber account. *See* paragraph [0032].

The *Chua* application also fails to disclose assigning the primary telematics unit identifier to a mobile handset. The *Chua* application discloses assigning identity information, such as an electronic serial number (ESN) and a mobile identification number (MIN), to the wireless telephone 110 and assigning different identity information, such as a vehicle identification number (VIN), to the vehicle 120. *See* paragraph [0031].

Claims 10 and 20; claim 21; and claim 22 depend directly from independent claims 1, 11, and 19, respectively. Therefore, the dependent claims include all the elements and limitations of their respective independent claims. The Applicant therefore respectfully submits that dependent claims 10 and 20-22 are allowable over the *Chua* application for at least the same reasons as set forth above.

Regarding claim 10, the only mobile identification number disclosed by the *Chua* application is a mobile identification number (MIN) of wireless telephone 110. *See* paragraph [0031]. Therefore, the *Chua* application fails to disclose the telematics unit identifier being a mobile identification number, as recited in claim 10.

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Regarding claims 20-22, the *Chua* application fails to disclose a primary vehicle as discussed above for claims 1, 11, and 19. Therefore, the *Chua* application fails to disclose the primary telematics unit identifier being an identifier associated with a telematics unit in a primary vehicle.

Withdrawal of the rejection of independent claims 1, 10, 11, and 19-22 under 35 U.S.C. §102(e) as being anticipated by the *Chua* application is respectfully requested.

B. Claims 2-5, 9, 10, and 12-15 were rejected under 35 U.S.C. §103(a) as being unpatentable over the *Chua* application in view of *Simonds, et al.* (US 2004/0092253).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 2143. The Applicants respectfully submit that the *Chua* and *Simonds* applications, alone or in combination, fail to teach or suggest all the claim limitations as required to maintain the obviousness rejection.

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Claims 2-5, 9, and 10, and claims 12-15 depend directly or indirectly from independent claims 1 and 11, respectively, and so include all the elements and limitations of their respective independent claims. The *Chua* application fails to teach or suggest a primary telematics unit identifier, as discussed in Section A above. U.S. Patent Application No. 2004/0092253 to Simonds, *et al.* (the *Simonds* application) also fails to disclose this limitation. The Applicants therefore respectfully submit that dependent claims 2-5, 9, 10, and 12-15 are allowable over the *Chua* application in view of the *Simonds* application for at least the same reasons as set forth above with respect to their respective independent claims.

Regarding claims 2-4, the Applicant respectfully requests that the Examiner point out where in Figs. 10 and 11 of the *Simonds* application as cited by the Examiner, or in the associated text, that the elements of the claims are to be found.

Withdrawal of the rejection of claims 2-5, 9, 10, and 12-15 under 35 U.S.C. §103(a) as being unpatentable over the *Chua* application in view of the *Simonds* application is respectfully requested.

C. Objected to but allowable claims.

The Examiner objected to claims 6-8 and 16-18 as being dependent on rejected base claims, but allowable if rewritten in independent form. Claims 6-8 and Claims 16-18 depend directly or indirectly from independent claims 1 and 11, respectively. Therefore, the dependent claims include all the elements and limitations of their respective independent claims. The Applicant submits that dependent claims 6-8 and 16-18 are allowable over the cited references for at least the same reasons as set forth above for their respective independent claims. Withdrawal of the objection to dependent claims 6-8 and 16-18 is respectfully requested.

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CONCLUSION

Reconsideration of the rejection of claims 1-5, 9-15, and 19-22 is requested in light of the remarks herein. The Applicants submit that claims 1-22 as set forth fully satisfy the requirements of 35 U.S.C. §§102, 103, and 112. In view of foregoing remarks, favorable consideration and early passage to issue of the present application are respectfully requested.

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Respectfully submitted,
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